

**AMENDMENTS TO THE DRAWINGS**

Fig. 11 has been amended to include an insulating layer 6 on a lower surface of semiconductor chip 1'.

**REMARKS**

At the time of the Final Office Action dated April 26, 2004, claims 22-25 were pending and rejected in this application.

On page two of the Office Action, the Examiner asserted that the drawings fail to show a second electrode formed on an insulating layer that is on the same surface of the semiconductor chip. Fig. 11 has been amended to include the feature. It is widely known that surface of a semiconductor chip is not completely conductive; otherwise, the semiconductor chip would short-circuit itself. Instead, the semiconductor chip is enclosed in a protective insulating layer and only at certain positions does the surface of the semiconductor chip include conductive features (e.g., electrodes). By amending Fig. 11 to show that a surface of the semiconductor chip includes an insulating layer, Applicants have merely explicitly shown what is implicitly known to already be present. Thus, Applicants submit that no new matter has been added.

With regard to claim 25, the Examiner asserted that the “drawings fail to show a combined structure of claims 22 and 25 conductive line patterns formed on the both surfaces of the lower semiconductor chip.” Applicants respectfully disagree with the Examiner's characterization of claim 25 since claim 25 does not recite conductive line patterns formed on both sides of a lower semiconductor chip. Instead claim 25 recites that a conductive line pattern is formed on a first major surface of a lower semiconductor device and a conductive line pattern is formed on a second major surface of an upper semiconductor device. These features are

shown, for example, in Fig. 13 of Applicants' disclosure. Applicants, therefore, respectfully solicit withdrawal of the imposed objection to the drawings.

**CLAIM 23 IS REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY SEIDLER,**  
**U.S. PATENT NO. 4,780,098**

Applicants have already distinguished certain of the limitations recited in claim 23 over Seidler in the Amendment filed August 4, 2003. In the Amendment filed January 23, 2004, claim 23 was placed in independent form and included the limitations previously presented in claim 20, which was newly added in the Amendment filed August 4, 2003.

In responding to an anticipation rejection based upon Seidler, Applicants stated the following in the Amendment filed August 4, 2003:

Newly added independent claim 20 recites, in part, the following limitation: "at least one conductive member... covering a side surface of said semiconductor chip." This feature is shown, for example, in Fig. 4 of Applicants' disclosure. In the fourth enumerated paragraph on page three of the Office Action, the Examiner referred to Fig. 8 of Seidler and asserted that feature 260 corresponds to the claimed semiconductor chip and feature 210 corresponds to the claimed conductive member. As apparent from Fig. 8 of Seidler, the side surface (right side of feature 260) of the substrate 260 is not covered by the lead 210. Instead, the lead 210 is positioned apart from the substrate 260. Thus, Seidler fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

Although the Examiner referred to Fig. 9 of Seidler in the current rejection and Fig. 8 of Seidler in the prior rejection, Figs. 8 and 9 both fail to teach or suggest at least one conductive member covering a side surface of a semiconductor chip. Thus, Applicants submit that Seidler fails to identically disclose the claimed invention as recited in claim 23, and Applicants respectfully solicit withdrawal of the imposed rejection of claim 23 under 35 U.S.C. § 102 for anticipation based upon Seidler.

**CLAIMS 23 AND 24 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY KOMIYAMA, U.S. PATENT NO. 4,780,098 (HEREINAFTER KOMIYAMA)**

The filing of a foreign priority application under 35 U.S.C. § 119 is a constructive reduction to practice of the invention for purposes of establishing priority for a U.S. application. Thus, the U.S. application may use the filing date of the foreign application as the date of the invention to establish priority to antedate a prior art reference. As acknowledged by the Examiner in the summary of the Office Action dated August 22, 2001, Applicants submitted a claim of priority to a foreign application with a filing date of February 10, 2000. As the filing date of Komiyama is March 28, 2000, Applicants have antedated the applied prior art of Komiyama.

To establish a prima facie case under both 35 U.S.C. § 102 subsection (a) and (e), the Examiner is required to establish that the invention was patented by another before the invention thereof by Applicants. However, Applicants have established constructive reduction to practice of the invention on February 10, 2000, which is before the filing date of Komiyama. Therefore, Applicants submit that the Examiner cannot establish a prima facie case under 35 U.S.C. § 102 for anticipation based upon Komiyama; and thus, Applicants respectfully request that the rejection of claims 23 and 24 be withdrawn.

**CLAIM 22 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SEIDLER IN VIEW OF HABA ET AL., U.S. PATENT NO. 6,014,316**

In the statement of the rejection, the Examiner relied upon Fig. 11 of Haba to teach a conductive line pattern extending from a second to an inner electrode. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner improperly relied on Haba to teach these particular limitations. The present application has a filing date of August 11, 2000, which is earlier than October 10, 2000, the filing date of Haba. Although Haba claims priority to Application No. 09/471,302 (the '302 application), filed on December 23, 1999,<sup>1</sup> the '302 application does not disclose the feature being relied upon by the Examiner in the current rejection. The '302 application eventually issued as U.S. Patent No. 6,621,155 (the '155 patent).

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<sup>1</sup> Haba issued as an application filed as a continuation-in-part of the '302 application.

Upon reviewing the '155 patent, Applicants note that the '155 patent only contains 14 sheets of drawings (Figs. 1-9) whereas Haba contains 17 sheets of drawings (Figs. 1-14). Applicants further note that Figs. 1-9 of the '155 patent and Figs. 1-9 of Haba are identical. Therefore, the new material added to Haba, which was not originally disclosed by the '155 patent, are sheets 15-17, which correspond to Figs. 10-14. The Examiner, however, relied upon Fig. 11 of Haba to teach the claimed features missing in the primary reference.

The subject matter disclosed by Fig. 11 of Haba is not entitled to the priority date of the '302 application because Fig. 11 was not disclosed in the parent '302 application (i.e., the '155 patent). Instead, the subject matter disclosed by Fig. 11 of Haba is only entitled to a filing date of October 10, 2000. Since the subject matter allegedly disclosed by Fig. 11 of Haba has an effective filing date later than the filing date of the claimed invention, the Examiner has improperly applied Haba against the claimed invention. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claim 22 under 35 U.S.C. § 103 for obviousness based upon Seidler in view of Haba.

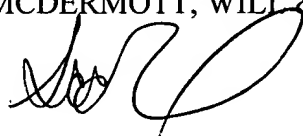
Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Application No.: 09/635,902

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Scott D. Paul', is written over the firm name.

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